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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/690,607

10/23/2003

Tsuyoshi Maeda

117304

6772

25944

7590

12/26/2006

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

SCHÉCHTER, ANDREW M

ART UNIT

PAPER NUMBER

2871


MAIL DATE

DELIVERY MODE

12/26/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Application Number 	Application/Control No. 10/690,607 David Nelms	Applicant(s)/Patent under Reexamination MAEDA, TSUYOSHI Art Unit 2871
Document Code - AP.PRE.DEC		

Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 11/13/06.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:
 Claim(s) allowed: _____
 Claim(s) objected to: _____
 Claim(s) rejected: 1, 2, 7, 15, 18, 21-23, 29-31 and 34-41.
 Claim(s) withdrawn from consideration: _____

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) David Nelms 

(3) David Blum 

(2) Andrew Schechter 

(4) _____

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER

20061219

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.


Commissioner for Patents

The applicant's arguments filed on 13 November 2006, with a Pre-Appeal Brief Request for Review, have been fully considered but they are not persuasive.

1. On page 2, the applicant states that "the Office Action asserts that the only teaching from Yano that is applied is the thickness of the retardation plates". This is not correct, and appears to be a typographical error. It is not the "thickness" which is taught by Yano, but the thicknesswise retardation or phase difference value which is taught by Yano.
2. On page 2, the applicant argues that the optical device in Yano is incapable of converting linear polarized light to circular polarized light, as the retardation plate of Jisaki does, so one skilled in the art would not assume that Yano's range of retardations would be appropriate for use in the retardation plate of Jisaki. This is not persuasive. To be clear, within the XY plane, Yano has $n_x \sim n_y$ so no conversion takes place, while Jisaki has $(n_x - n_y)d$ be about a quarter wavelength, which has the effect of converting linear to circular. Yano's teaching gives the preferred phase difference value between the refractive indices in the XY plane (n_x, n_y) and the refractive index in the Z-axis direction (n_z). Yano teaches the range which is appropriate for higher-order compensation, a separate issue from the in-plane retardation, and it appears to the examiner, based on the Yano and Terashita references, that one of the ordinary skill would find this range beneficial for both the $n_x \sim n_y$ and $n_x > n_y$ (quarterwave) plates.
3. On pages 2-3, the applicant argues that $n_{y1} = n_{z1} = 0$ is a physical impossibility, so the assertions of the office action [in the Response to Arguments section, p. 2 of the 10 August 2006 action] are "pure speculation with no factual basis". This is not persuasive. The applicant is correct, of course, that these values are always greater than 1. However, the gist of the examiner's reasoning is correct. Where the examiner wrote " $n_{y1} = n_{z1} = 0$ (making the biaxiality small)" and "non-zero values of n_y and n_z ", he should have written " $n_{y1} - n_{z1} = 0$ (making the biaxiality small)" and "a non-zero value of $n_y - n_z$ ". As stated by the examiner, in this limiting situation Jisaki alone would meet the recited inequalities in the claims. For instance, the inequality from claim 38:
$$0.5 R_r \leq [(n_x + n_y)/2 - n_z] d \leq 0.75 R_r$$
with Jisaki disclosing the $R_r = \lambda/4 = (n_x - n_y)d$ becomes
$$0.5 R_r \leq [0.5 R_r + (n_y - n_z) d] \leq 0.75 R_r$$
so the inequality is clearly met for small biaxiality, when n_y is just slightly larger than n_z .
Thus, the examiner is correct in saying that in the limit of small biaxiality Jisaki's plate meets the claim limitation, and when larger biaxiality is considered, Yano teaches having a closely overlapping range to that claimed in order to achieve "a wide viewing angle through higher grade compensation". Finally, on this point, the rejection as written under "Claim Rejections - 35 USC 103" is correct in all details.

4. On page 3, the applicant argues that "Yano explicitly requires $nx1=ny1$ to eliminate optical rotary dispersion. This is the whole purpose of Yano" so using $nx>ny$ cannot be done when using Yano; in effect Yano teaches away from $nx>ny$. This is not persuasive. Yano discloses $nx1=ny1$, but the examiner sees nothing in Yano to suggest that this is the "whole purpose" of Yano, or that Yano's teaching of the desirable ranges for higher grade compensation are appropriate only for $nx1=ny1$. In the examiner's opinion, nothing in Yano's discussion rises to the level of an explicit "teaching away" from using $nx>ny$, as Jisaki does. Furthermore, the rejection does not use Terashita to modify Yano, making it "not operate for its intended purpose"; rather, Yano and Terashita are cited as evidence of the obviousness of modifying Jisaki.

For these reasons, the arguments filed in the Pre-Appeal Request for Review were found to be unpersuasive.


Andrew Schechter
Primary Examiner
Technology Center 2800
20 December 2006